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EXAMINER

MAHONEY, CHRISTOPHER E

ART UNIT	PAPER NUMBER
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2851

DATE MAILED: 09 16 2002

Please find below and or attached an Office communication concerning this application or proceeding.

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Pursuant to the Remand under 37 CFR 1.196(a) by the Board of Patent Appeals and Interferences on April 25, 2002, a supplemental action is set forth below:

The first section contains the rejections affirmed by the Board of Patent Appeals.

The second contains matters considered by the examiner as instructed by the Board of Patent Appeals in the Remand of April 25, 2002.

DETAILED ACTION

1. REJECTIONS AFFIRMED BY THE BOARD OF PATENT APPEALS.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For further explanation the applicant is directed to review the Final Rejection mailed August 11, 1998 (paper #29) and the Examiner's answer mailed June 8, 1999 (paper #36).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Guez (U.S. Patent No. 4,827,291). The applicant is directed to review the previous Office Action (paper # 29) and the Decision by the Board of Appeals (paper #44) mailed on April 25, 2002 in reference to the details of this rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guez (U.S. Patent No. 4,827,291) in view of Jones (U.S. Patent No. 4,304,471). The applicant is referred to the previous Office Action (paper # 29) and the Decision by the Board of Appeals (paper #44) mailed on April 25, 2002 for reference to the details of this rejection.

2. RECONSIDERATION OF THE AFFIDAVITS UNDER 37 CFR 1.131

The Board of Patent Appeals and Interferences (BPAI) has remanded the present application with instructions for the examiner to reconsider the Declarations made by the applicant under 37 CFR 1.131.

The BPAI states that 37 CFR § 1.131(a) (July 1, 1994) as amended at 53 Fed. Reg. 23734 (June 23, 1988) was controlling at the time of applicant's filing the declarations. The examiner notes that both declarations were signed and submitted after May 1, 1995. As such, 37 CFR §1.131(a) (July 1, 1995) 53 Fed. Reg. 23734, June 23, 1988, as amended at 60 Fed. Reg. 21044 (*May 1, 1995*) was controlling at the time of applicant's filing the declarations.

37 CFR 1.131 states:

“(a)(1) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 102(a) or (e), or 35 U.S.C. 103 based on a U.S. Patent to another which is prior art under 35 U.S.C. 102 (a) or (e) and which substantially shows or describes but does not claim the same patentable invention, as defined in 37 CFR 1.601(n), or on reference to a foreign patent or to a printed publication, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under 37 CFR 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to overcome the patent or publication. The oath or declaration must include facts showing a completion of the invention in this country or in a NAFTA or WTO member country before the filing date of the application on which the U.S. patent issued, or before the date of the foreign patent, or before the date of the printed publication. When an appropriate oath or declaration is made, the patent or publication cited

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shall not bar the grant of a patent to the inventor or the confirmation of the patentability of the claims of the patent, unless the date of such patent or printed publication is more than one year prior to the date on which the inventor's or patent owner's application was filed in this country.

(2) A date of completion of the invention may not be established under this section before December 8, 1993, in a NAFTA country, or before January 1, 1996, in a WTO Member country other than a NAFTA country."

The examiner notes that section (a)(1) distinguishes between this country and a NAFTA country. The examiner therefore believes that paragraph (a)(2) does not refer to this country when indicating that completion of the invention may not be established under this section before December 8, 1993, in a NAFTA country.

The BPAI indicates that the declarations under 37 CFR 1.131 were determined by the examiner to have overcome the Spector '832, Spector '224, Olson, Kirkendall, and Wheeler references.

This is not the case. For example, the examiner repeated art rejections based on Spector '832, Spector '224, and Kirkendall, respectively or in combination in papers 11 and 14. If anything, the examiner did not comment on the declarations. The examiner will thus reevaluate the effectiveness of the § 1.131 declarations in removing the above listed references as instructed by the BPAI.

If the date of a reference is more than one year prior to the date on which the application is filed, the declaration is ineffective to establish prior invention to overcome a prior art rejection. As stated by the BPAI both Spector '832 and Spector '224 have issue dates more than one year prior to the date of filing of the present application. Accordingly, the declarations are

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ineffective for overcoming prior art rejections based solely on either Spector reference under 35 U.S.C. §§ 102 or 103. The examiner has therefore reevaluated the disclosures of Spector '224 and Spector '832 to determine whether they teach the limitations of current claims.

Regarding the Olson, Kirkendall and Wheeler references, the examiner has reviewed these references. The claims as originally filed may or may not have been the subject of an interference. However the claims as now pending have a date no earlier than July 7, 1997 (claim 1 was amended in paper #23). No interference will be declared at this time because the claims as presented were not copied or presented prior to one year of the issue date of the Olson, Kirkendall, and Wheeler references. The applicant's claims as presented in any future responses will be reevaluated with respect to all five of the references (Spector '832, Spector '224, Olson, Kirkendall and Wheeler) to ensure compliance with 35 U.S.C. §§ 102, 103, and 135.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3, 4, 5, 6, 8, 11, 12, 13, 14, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Spector (U.S. Patent No. 4,994,832). Spector '832 teaches a package of photographic film (col. 3, lines 1-4) comprising a plurality of frames to be exposed, each exposable photographic frame comprising a first unexposed portion and a second unexposed portion (col. 2, line 32). Claim 1 recites steps, when used in conjunction with the list of film types listed in col. 3, which anticipate the steps of applicant's claims 17, and 12-13. Regarding applicant's claim 14, Spector '832 teaches, in figure 2 for example, that the film items are not all identical.

Claims 1, 3, 4, 5, 6, 8, 11, 12, 13, 14, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Spector (U.S. Patent No. 5,111,224). Spector '224 teaches a package of photographic film (col. 1, lines 9-12 incorporation by reference) comprising a plurality of frames to be exposed, each exposable photographic frame comprising a first unexposed portion and a second unexposed portion (col. 2, lines 17-20). Claim 1 recites steps, when used in conjunction with the list of film types listed in col. 3, which anticipate the steps of applicant's claims 17, and 12-13. Regarding applicant's claim 14, Spector '224 teaches, in figure 2 for example, that the film items are not all identical. The applicant is directed to review figures 2-3, col. 1, lines 9-12, col. 2, lines 17-27 and 58-62, col. 3, lines 6-31 and claim 1 of Spector '224.

Claim Rejections - 35 USC § 103

Claims 2, 16 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector (U.S. Patent No. 4,994,832) in view of Guez (U.S. Patent No. 4,827,291). Spector

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teaches the salient features of the claimed invention except for each second portion surrounding the first portion. Guez teaches in col. 10, lines 40-43 that it was known to create/preexpose either an entire foreground or an entire background first, where as shown in figure 8, the entire background surrounds the foreground. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features as taught by Guez for the purpose of creating a picture of a subject against a selected image as a background.

Claims 2, 16 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector (U.S. Patent No. 5,111,224) in view of Guez (U.S. Patent No. 4,827,291). Spector '224 teaches the salient features of the claimed invention except for each second portion surrounding the first portion. Guez teaches in col. 10, lines 40-43 that it was known to create/preexpose either an entire foreground or an entire background first, where as shown in figure 8, the entire background surrounds the foreground. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the features as taught by Guez for the purpose of creating a picture of a subject against a selected image as a background.

Response to Arguments

Applicant's arguments filed October 23, 1995 have been fully considered but they are not persuasive. The applicant discusses disadvantages of the Spector references but does not point out specifically what the applicant has claimed that distinguishes it over the Spector references. It is understood that the applicant's argument's which were filed October 23, 1995 were addressing a different Office Action and the claims were different at that time and that any future amendment(s) and argument(s) will address the issues in the current Office Action. The

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examiner has reviewed the applicant's arguments which discuss the Spector references in order to expedite prosecution.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E Mahoney whose telephone number is (703) 305-3475. The examiner can normally be reached on 8:30AM-5PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on (703) 308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

CM
September 11, 2002



Christopher E Mahoney
Primary Examiner
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